

REMARKS

The Applicant does not believe that examination of the foregoing amendment will result in the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the foregoing amendment be entered and that the claims to the present application, kindly, be reconsidered.

The Office Action dated August 9, 2005 has been received and considered by the Applicant. Claims 1-23 are pending in the present application for invention. The Office Action rejects Claims 1-23.

The Office Action objects to claims 1, 5, 6, 9, 11, 13, 18, 20, 21 and 23 due to various informalities. The foregoing amendment to the claim has generally corrected these oversights, except for those objections related to "further comprising". The Applicant, respectfully, points out that these amendments are made solely for the purpose of correcting informalities and do not narrow the claims. Therefore, the amendments made in response to these objections should have no effect upon interpretation of equivalents to the present invention.

The Office Action rejects Claims 1-3, 5, 6, 9, 10 and 23 under the provisions of 35 U.S.C. §102(b) as being anticipated by JP 01253638 by Tsuchiya et al. (hereinafter referred to as Tsuchiya et al.). The Examiner states that Tsuchiya et al. disclose a method of examining a record carrier for the presence of a defect.

Regarding Claim 1, the Examiner further states that Tsuchiya et al. teach following a track to be examined, monitoring the resulting tracking signal (at page 7, last paragraph) and rating the examined recording track for the presence of media defects on the basis of characteristics of the resulting tracking signal (at page 8, first paragraph). The Applicant disagrees with this assertion contained in the Office Action. The last paragraph on page 7 of Tsuchiya et al. discusses a simple optical system having decoding to compute the playback (RF) signal and the tracking error (TE) signal. There is no disclosure or suggestion for monitoring the tracking signal. However in an effort to move this case towards allowance, Claim 1 has been amended to define subject matter for determining if recording should be discontinued based on the rating indicating that the resulting recording track contains defects. This subject matter is not disclosed or suggested by Tsuchiya et al. Claim 13 has been amended in a manner similar to Claim 1.

Regarding 2, the Office Action asserts that Tsuchiya et al. disclose that the examined recording track is rated as being defective if the absolute value of the tracking signal has a value which exceeds a predetermined signal threshold for a predetermined period of time or longer. The Applicant, respectfully, disagrees. There is no disclosure or suggestion within Tsuchiya et al. for determining the absolute value of the tracking signal. Therefore, this rejection is traversed.

Regarding claim 3, the Office Action asserts that Tsuchiya et al. disclose that the tracking signal has a nominal signal value of zero which corresponds to the center of a track, and has a maximum value which corresponds to a maximum lateral deviation with respect to the center of a track. The Applicant, respectfully points out that these features are not discussed by Tsuchiya et al. Furthermore, there is no disclosure or suggestion and wherein a level of a preselected fraction of the maximum value is chosen as the predetermined signal threshold by Tsuchiya et al. There is no disclosure or suggestion for the "threshold value" in Figure 3 of Tsuchiya et al. to be a "preselected fraction" of the tracking signal. The Applicant, respectfully points out that the signal shown in Figure 3 of Tsuchiya et al. is a playback signal and not a tracking signal. Therefore, this rejection is traversed.

Regarding claim 5, the Office Action states that Tsuchiya et al. disclose that the record carrier is examined for the presence of spot defects including: examining the integrity of predetermined test tracks of the record carrier; and examining the integrity of tracks adjacent the relevant test track each time that upon the examination a test track appears to be defective, in order to determine in this way the number of tracks affected by the same spot defect.

The Examiner further states that Tsuchiya et al. disclosed entering the relevant tracks in a defect list each time that the number determined is greater than a predetermined threshold value. The Examiner states that this subject matter is disclosed on page 8, paragraph 1, last four lines of Tsuchiya et al. There is no disclosure, or suggestion, for entering the relevant tracks in a defect list each time that the number determined is greater than a predetermined threshold value within Tsuchiya et al.

Regarding Claim 6, the Office Action states that Tsuchiya et al. disclose that a predetermined number of tracks between successive test tracks is skipped. Claim 6 depends from to Claim 5 which is believed to be allowable for the above stated reasons, therefore Claim 6 and is also believed to be allowable.

Regarding Claim 9, the Office Action states that Tsuchiya et al. disclose that the record carrier is examined for the presence of spot defects including examining the integrity of predetermined test tracks of the record carrier. The Applicant disagrees with the Examiner's assertion that Tsuchiya et al. teach entering the relevant tracks in a primary defect list each time that upon the examination of a test track it appears to be defective and entering tracks situated in a suspect area at opposite sides of the relevant test track in an alarm list. There is no disclosure or suggestion for deterring a primary defect list and entering tracks situated in a suspect area at opposite sides of the relevant test track in an alarm list within Tsuchiya et al. Furthermore, there is no disclosure or suggestion storing both the primary defect list and the alarm list in a memory. There is no teaching for storing multiple lists within Tsuchiya et al.

Regarding claim 10, the Office Action asserts that Tsuchiya et al. disclose that a predetermined number of tracks between successive test tracks is skipped, and wherein each suspect area always extends from the relevant test track to the directly preceding and the directly following test track, respectively. Claim 10 depends from Claim 9 which is believed to be allowable for the above stated reasons, therefore Claim 10 and is also believed to be allowable.

Regarding claim 23, the Office Action asserts that Tsuchiya et al. disclose a method of examining a record carrier for the presence of a defect including monitoring a track to be examined and generating a tracking signal from the track that is monitored; rating the track for the presence of spot defects based on characteristics of the tracking signal; and entering the track into a defect list if the track appears to be defective. The Examiner further states that Tsuchiya et al. disclose creating a suspect area list for other tracks at opposite sides of the track if the track appears to be defective; which the Applicant, respectfully, disagrees with. There is no disclosure or suggestion for creating multiple lists or an additional list for other tracks at opposite sides of the track if the track appears to be defective within Tsuchiya et al.

The Office Action rejects Claims 4, and 18-20 under the provisions of 35 U.S.C. §103(a) as being obvious over JP 01253638 by Tsuchiya et al. (hereinafter referred to as Tsuchiya et al.).

Regarding Claim 18, the Office Action asserts that Tsuchiya et al. disclose that the tracking signal has a nominal signal value of zero that corresponds to the center of a track, and has a maximum value which corresponds to a maximum lateral deviation with respect to the center of a track. The Examiner further asserts that Tsuchiya et al. disclose a level of a

preselected fraction of said maximum value is chosen as the predetermined signal threshold. The Applicant disagrees with the foregoing assertion. The Applicant submits that these elements are not disclosed by Tsuchiya et al.

Regarding claim 4, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention that the predetermined period of time lies in a range from approximately 50 μ s to approximately 75 μ s; in claim 18, that the preselected fraction is equal to approximately 0.5; in claim 19, that said predetermined period of time is approximately 60 μ s; and in claim 20, that approximately 50 tracks between successive test tracks are skipped. The Applicant disagrees that the foregoing are simply a matter of design choice. Therefore, this rejection is traversed.

The Office Action rejects Claims 7, 8, 11 and 12 under the provisions of 35 U.S.C. §103(a) as being obvious over Tsuchiya et al. in view of U.S. Patent No. 5,237,553 in the name of Fukushima et al. (hereinafter referred to as Fukushima et al.) The Office Action assert that Tsuchiya et al. disclose a record carrier having recording tracks; and a defect list of tracks affected by a large spot defect. The Examiner further asserts that Tsuchiya et al. disclose a primary defect and, optionally, an alarm list of tracks situated in a suspect area at opposite sides of the relevant test tracks. The Applicants disagree with this assertion by the Examiner. There is no disclosure or suggestion within Tsuchiya et al. for an alarm list of tracks situated in a suspect area at opposite sides of the relevant test tracks. Therefore, this rejection is traversed.

The Office Action rejects Claims 13-17, 21 and 22 under the provisions of 35 U.S.C. §103(a) as being obvious over Tsuchiya et al. in view of U.S. Patent No. 5,237,553 in the name of Takasago et al. (hereinafter referred to as Takasago et al.). The Applicant, respectfully, points out that Tsuchiya et al. pertains to detection of defects; while Takasago et al. pertains to detection of an off track situation.

Regarding to claim 13, the Office Action asserts that Tsuchiya et al. disclose a method of recording information on a record carrier, including: monitoring a recording track to provide a rating of defects contained on the track. The Examiner admits that the combination of Tsuchiya et al. within Takasago et al. does not disclose: regarding claim 13, based on the resulting tracking signal determining whether the recording process is to be continued or

discontinued; and regarding claim 14, that the recording process is discontinued if the absolute value of the tracking signal appears to have a value which exceeds a predetermined signal threshold for a predetermined period of time or longer. The Examiner asserts that Takasago et al. disclose determining whether a recording process is to be continued or discontinued based on a resulting tracking signal; and the recording process is discontinued if the absolute value of the tracking signal appears to have a value which exceeds a predetermined signal threshold for a predetermined period of time or longer.

The Examiner admits that Tsuchiya et al. in view of Takasago et al. is silent regarding: in claim 16, that said predetermined period of time lies in a range from approximately 50 μ s to approximately 75 μ s; in claim 21, that the preselected fraction is approximately 2/3; and in claim 22, that said predetermined period of time is approximately 60 μ s. The Examiner's position is that these features are a matter of design choice.

The rejection has failed to show the recitation for the predetermined threshold being either 0.5 or 2/3 of the maximum value corresponding to the maximum lateral deviation is used for a particular purpose, or solves a stated problem. Initially, the Applicant, respectfully, points out that the Examiner has not provided any authority that allows for this line of reasoning to be used within an obviousness rejection. Moreover, the Applicant points out that there is a clear purpose and advantage to the stated limitations in that the present invention is rating the track.

The Applicant draws the Examiner's attention to page 10, lines 4-8 of the specification of the present invention wherein the tracking error of 0.5 of the maximum value is disclosed as the preferred error tracking parameter to if the track is defective. Accordingly, there is a stated purpose to the tracking error of 0.5 of the maximum value as recited by rejected Claim 18 contrary to the assertions of the Examiner. The limitations of the claims must each be given consideration. The Examiner may not simply brush aside specific limitations by reading the same reference voltages of Takasago et al. on the predetermined threshold and the specifically different recitations of the preselected fractions that are used to determine that predetermined threshold. The Applicant, respectfully, submits that the reason that Takasago et al. do not disclose, or suggest using fractions of the reference voltages is that Takasago et al. has no such stated purpose for rating the track for defects..

The specification of the present invention at page 12, lines 14-22 wherein the value of 2/3 is discussed as preventing accidental writes to the adjacent track. Accordingly, there is a stated purpose to 2/3 fractional amount recited by rejected Claim 21 contrary to the assertions of the Examiner. The Applicant points out that of the cited reference, Takasago et al. has no such stated purpose. The Applicant, respectfully, submits that the reason that Takasago et al. do not disclose, or suggest using fractions of the reference voltages is that Takasago et al. has no such stated purpose for preventing accidental writes to the adjacent track.

The rejection admits that Takasago et al. do not disclose the predetermined time periods recited by the rejected claims in a range between 50 μ s and 75 μ s. Furthermore, regarding claims in 19 and 22, the Examiner states that Takasago et al. do not disclose that the recited period of time is approximately 60 μ s. The Applicant, respectfully, points out that the rejection does not contend that Takasago et al. suggest implementing any of the foregoing time periods. The Examiner's position is that it would have been obvious for a person of ordinary skill in the art because the Applicant has not disclosed any advantage to these time periods. Initially, the Applicant objects to the line of reasoning used in this rejection because the Examiner has not provided any authority that such a line of reasoning is valid for making a rejection based on obviousness. Moreover, the advantages are clearly stated in the specification. The advantage of recited period of time is approximately 60 μ s is given by the specification of the present invention at page 12, lines 14-22 wherein the value of 60 μ s is discussed as preventing accidental writes to the adjacent track. The range between 50 μ s and 75 μ s is used as a range around the preferred value of 60 μ s as an acceptable range. The Applicant's position is that the rejection employs improper hindsight in this obviousness analysis. In order to determine obviousness there must be some suggestion or motivation within the prior art to make the modification. The rejection provides no such suggestion of motivation within the cited prior art referenced to make the modification made in the Final Office Action. The Examiner has also not advanced any authority to support the assertion made in the Final Office Action that the foregoing rationale is a proper rationale for determining obviousness.

The MPEP at §2143 states that to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." The Applicant respectfully points out that the rejection does not satisfy any of the three foregoing criteria and, therefore, has not made a *prima and facie* case of obviousness. Moreover, the motivation to make the modification suggested by the Examiner must be found within the prior art reference, and the Examiner has in fact stated that is not found within Takasago et al. The Applicant, respectfully, asserts out that a person skilled in the art would not be motivated by the teaching of Takasago et al. to make the modification suggested by the Final Office Action. Takasago et al. pertains to identifying digressions within the tracking signal and correcting tracking errors. Takasago et al. does not pertain to identifying defective areas on a disk. For the foregoing reasons, this rejection is respectfully traversed.

Regarding Claim 13, as amended determines continuing or discontinuing based on the rating of the tracking error signal. Tsuchiya et al. do not teach or suggest continuing or discontinuing based on the rating of the tracking error signal. Takasago et al. do not teach continuing or discontinuing based on the rating of the tracking error signal. The Applicant, respectfully, submits that Claim 13 is allowable.

Regarding Claim 14, the Examiner states that Takasago et al. disclose that the recording is discontinued if the tracking signal exceeds a predetermined value for a predetermined period of time at column 5, line 47- column 6, line 14. The Applicant, respectfully, points out that column 5, line 47 - column 6, line 14 of Takasago et al. teach that if the digression of the tracking signal reaches a certain level, an indication that tracking signal is off track will result by multiple logical "1" pulses being emitted. The multiple logical "1" pulses result from a sway in the tracking signal as shown in FIG. 3b, reference numeral 16, of Takasago et al.; which is not equivalent to exceeding a predetermined threshold for a predetermined period of time. The additional period of time referred to by Takasago et al. is the additional logical "1" pulses themselves and not a period of time that the tracking signal exceeds a threshold. Takasago et al. do not disclose or suggest that if the tracking signal exceeds a predetermined value for a predetermined time, that the recording process is discontinued. Takasago et al. teach that the off-track signal is sent to a latch circuit 28 if the duration of time exceeds another time

period, T2 (see column 6, lines 7-13). The output signal 39 of latch circuit 28 does not indicate that recording is to be halted, but instead that recording continues in a different area (see column 6, lines 60-68). Takasago et al. teach that if the time width of the logical "1" being greater than T1 but less than T2, or the time width of the logical "1" being greater than T2, it is the logical "1" pulse for which the time duration is measured. Takasago et al. do not provide and disclosure or suggestion related to the time period of the tracking signal. Therefore, this rejection is, respectfully, traversed.

Regarding Claim and 15, the Examiner states that Tsuchiya et al. teach the predetermined threshold is a preselected fraction of the maximum value. The Applicant denies this allegation. Tsuchiya et al. do not disclose or suggest that the predetermined threshold is a preselected fraction of the maximum value. Therefore, this rejection is traversed.

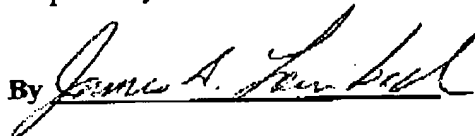
Regarding Claim 17, Takasago et al. do not disclose or suggest a recording device having thresholds that are a preselected fraction of the signal level representative of the maximum deviation of from the center of the track. Takasago et al. do not disclose or suggest a recording device that discontinues recording is the tracking signal exceeds a threshold for a predetermined period of time. Accordingly, this rejection is respectfully, traversed.

Regarding Claims 18 and 21, the Examiner states that Takasago et al. disclose at column 5, lines 49 - 51 a tracking signal having a nominal value of zero, and that the tracking signal has a maximum value. The Examiner also asserts that a preselected fraction of the maximum value is chosen as the predetermined signal threshold; which as previously discussed is an unfounded assertion. As discussed above, there is no teaching within Takasago et al. for the tracking error signal value to have a maximum value that occurs at a point of maximum lateral deviation from the center of the track. Takasago et al. teach that the error tracking signal swings from positive to negative during off track conditions. The Applicant, respectfully, requests that the Examiner indicate where within Takasago et al. there is any disclosure or suggestion that V_{REF} is a fraction portion of anything.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

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